



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,836	12/11/2003	Herman Rodriguez	AUS920030904US1(4026)	2190

45557 7590 06/25/2007

IBM CORPORATION (JSS)  
C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC  
6013 CANNON MOUNTAIN DRIVE, S14  
AUSTIN, TX 78749

EXAMINER
----------

GARG, YOGESH C

ART UNIT	PAPER NUMBER
----------	--------------

3625

MAIL DATE	DELIVERY MODE
-----------	---------------

06/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/733,836

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,15-19 and 28-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7,15-19 and 28-38 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed 4/4/2007 is entered. Claims 1, 3, 15, 19, 28, and 30 are amended and new claims 36 through 38 are new. Currently claims 1-7, 15-19 and 28-38 are pending.

### *Response to Arguments*

2. Applicant's arguments filed 4/4/2007 with respect to claims 1-7, 15-19 and 28-38 have been considered but are moot in view of the applicant's shift to claiming another invention after an election is once made and action given on the elected subject matter.

Newly submitted independent claim 37 and its dependency and currently amended independent claims 1, 15, and 28 and their dependencies are directed to an invention and/or inventions that are independent or distinct from the invention originally claimed for the following reasons:

Newly submitted claim 37 recites the limitation, "***gathering, via a bank application program interface.....***" which has a different and distinct utility than the earlier claimed invention in original independent claims 1, 15 and 28.

Currently amended independent claim 1 recites the limitation, "***associating an encrypted module...subsequent authentication***", which has a different and distinct utility than the earlier claimed invention in original independent claims 1, 15 and 28.

Currently amended independent claim 15 recites the limitation, "***a manufacturer application program interface to interact with a web site....from the manufacturer***

Art Unit: 3625

***based upon the electronic receipt***", which has a different and distinct utility than the earlier claimed invention in original independent claims 1, 15 and 28.

Currently amended claim 28 recites the limitation, "***identifying, via a receipt parser, the product via the electronic receipt; gathering, via a retailer application program interface...other than the merchant based upon the identifying...***", which has a different and distinct utility than the earlier claimed invention in original independent claims 1, 15 and 28.

Note 1: At present all four inventions as recited in currently amended claims 1, 15, 28 and the newly submitted claim 37 are distinct from each other as well and have different and distinct utility than the earlier claimed invention in original independent claims 1, 15 and 28.

The applicant has already elected an invention, that is originally filed claims 1-7, 15-19 and 28-30, drawn to a method/an apparatus and a machine readable medium containing instructions when executed would receive an electronic receipt describing a transaction for a purchase of a product, gathering and packaging product information about the product purchased product in the amendment received 10/31/2006 which did not require the utilities as recited in the newly submitted independent claim 37 and currently amended independent claims 1, 15 and 28.

Therefore the newly submitted independent claim 37 and currently amended independent claims 1, 15 and 28 are distinct and divergent from the earlier claimed invention and would require a new, divergent and different search. Such change in the inventions amount to a " Shift claiming another invention after an election is once made

Art Unit: 3625

and action given on the elected subject matter and are therefore subject to "Election by Original Presentation". as analyzed above.

Kindly refer to the following MPEP excerpts for guidelines:

### **819 Office Generally Does Not Permit Shift:**

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. **Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right).** When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in **MPEP § 821.03**.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

.....

### **821.03 Claims for Different Invention Added After an Office Action - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting**

#### **821.03 Claims for Different Invention Added After an Office Action**

Claims added by amendment following action by the examiner, **MPEP § 818.01, § 818.02(a)**, to an invention other than previously claimed, should be treated as indicated by **37 CFR 1.145**.

#### **37 CFR 1.145 Subsequent presentation of claims for different invention.**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in **§§ 1.143 and 1.144**

---

The action should include form paragraph 8.04.

**¶ 8.04 Election by Original Presentation.....**

.....

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

3. Therefore, newly submitted independent claim 37 and currently amended independent claims 1, 15 and 28 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons given above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly submitted independent claim 37, its dependency claim 38, currently amended independent claims 1, 15 and 28 and their dependencies are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The amendment filed on 4/4/2007 presenting only claims drawn to a non-elected invention is **non-responsive** (MPEP § 821.03). Therefore currently pending claims 1-7, 15-19 and 28-38 are not readable on the elected invention because they are subject to "Election by Original Presentation", as analyzed above.

5. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the

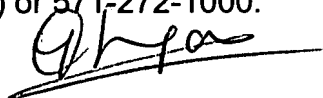
omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625